

## REMARKS

### Summary

Claims 1-13 were pending and all of the claims were rejected in the present Office action. Claim 1 has been amended to correct an informality. No new matter has been introduced. The Applicant has carefully considered the references and the arguments presented by the Examiner and respectfully traverses the rejections on the basis that a *prima facie* case of anticipation or obviousness has not been made out.

### Claim Rejections

#### **35 U.S.C. § 112, second paragraph**

Claims 1-13 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In particular, the Examiner asserts that Claims 1 and 11 are not meaningful since they define the invention in terms of the x-ray source, which is not claimed. The Applicant respectfully traverses the rejection. The preamble to Claims 1 and 11 recites, *inter alia*, an x-ray source. This provides appropriate antecedent basis for the recitation of "the x-ray source" at a later point in the claim, and thus the claims are definite. The Examiner is respectfully requested to withdraw the rejection.

#### **35 U.S.C. § 102(b)**

Claims 1-4 and 6-12 were rejected under 35 U.S.C. § 112(b) as being anticipated by Holstrom (US 3,784,837; "Holstrom"). The Applicant respectfully traverses these rejections on the basis that a *prima facie* case of anticipation has not been made out.

Claim 1 recites, *inter alia*, a support arm secured to a mounting device such that the x-ray source is secured rotatably about a substantially horizontal axis to the support arm and wherein a lower edge of the x-ray source is disposed below the lower edge of the support arm and the lower edge of the mounting

device independently of an x-ray source angle of rotation about the horizontal axis.

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” (emphasis added) *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir 1984) (citing *Connell v. Sears Roebuck & Co.* 722 F.2d 1542 220 USPQ 193 (Fed. Cir. 1983)).

Holstrom teaches a mounting device 5 to which a support arm 7 is mounted by a horizontal axis 6. An x-ray apparatus 1 is disposed such that it is connected to the mounting apparatus through a second arm and horizontal axes 8 and 12. Fig. 1 shows the apparatus in a first position (solid lines) and a second position (dashed lines). In the second position, the lowermost extremity (not labeled) of the x-ray apparatus 1 is seen to approximately the same vertical distance from the ceiling 4 as the lowermost portion (not labeled) of the mounting device 5, and further rotation of the arm 7 such that the arm 7 is disposed in a vertical position would raise the lowermost extremity of the x-ray device such that its vertical position was higher than that of the lowermost portion of the mounting device 5.

In making the rejection, the Examiner has identified axis 8 as the axis of rotation; however, the arms 7/9 may also be rotated about axes 6 and 12. For at least some angular rotations about one or more of the horizontal axes (6, 8, 12), the disposition of elements is such the lower edge of the x-ray apparatus 1 is higher than the lower edge of the mounting device 5 and thus the reference does not teach the arrangement of Claim 1, where the lower edge of the x-ray source is disposed below the lower edge of the mounting device independently of an x-ray source angle of rotation about the horizontal axis. Thus all of the elements and limitations of Claim 1 are not found in a single reference; Claim 1 is not anticipated and is allowable.

Further, the Examiner characterizes Holstrom as having “a mounting device 5 rotatable about axis 15, support arm 7/9 secured to the mounting device such that the x-ray source is rotatably secured to the support arm about a

horizontal axis 8....” (Office action, page 2). Figs. 1 and 2 of the reference illustrate these elements. In particular, the Applicant traverses the identification of “the support arm” referring indistinguishably to the elements 7 and 9, as shown in Fig.1 of the apparatus taught by Holstrom, as being ambiguous.

Element 7 of the reference is a first support arm being mounted so as to be secured to element 5 and rotatable about a horizontal axis 6 [not 8], the first support arm 7 further having horizontal axes 8 and 10 (see Fig. 1) disposed at opposing ends thereof. A first end of a second support arm 9 is mounted so as to be secured to the an end of first support arm 7 and rotatable about a horizontal axis 8, and a x-ray tube 1 is mounted so as to be secured to the second end of the second support arm 9 and rotatable about a horizontal axis 12.

Thus, Holstrom clearly teaches that there are at least two distinct support arms (three, if element 11 is considered): a first arm 7 rotatably attached to the mounting device 5 about horizontal axis 6; a second arm 9 rotatably attached to the first arm 7 about horizontal axis 8, and the x-ray tube 1 rotatably attached to second arm 9 about horizontal axis 12. Thus, the terms “arm” and “horizontal axis” as identified by identified by the Examiner are thus ambiguous as each term may refer to one of a multiplicity of arms and axes, respectively. It is well settled that an anticipation rejection cannot be predicated on an ambiguous reference (*In re Turlay*, 304 F.2d 893, 899 134 USPQ 355, 60(CCPA 1962)).

For at least the reasons given above, a *prima facie* case of anticipation has not been made out, and Claim 1 is allowable. Claims 2-10, being claims dependent on an allowable base claim, are allowable, for at least the same reasons. Claim 11, recites similar subject matter to the allowable subject matter in Claim 1, and is allowable for the same reasons. Claims 12-13, being claims dependent on an allowable base claim, are allowable, for at least the same reasons, at least as claims dependent on an allowable claim.

### **35 U.S.C. § 103 (a)**

Claims 5 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Holstrom. The Examiner makes an unsupported assertion to

justify the rejection. In the case of *In re Sang-Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), the court set forth the standards the Patent and Trademark Office ("PTO") must adhere to when rejecting a claim under 35 U.S.C. § 103. Specifically, when rejecting a claim for obviousness, the PTO must articulate the reasons for its decision. *Id.* at 1342. In particular, the PTO must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. *Id.* at 1343. When the examiner relies on what is asserted to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. As such a *prima facie* case of obviousness had not been made out and Claims 5 and 13 are allowable.

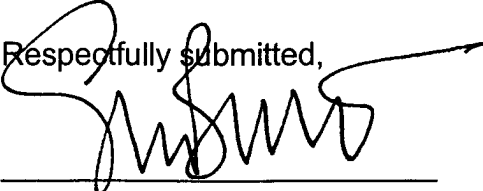
In the event that the present Claims 5 and 13 are not allowed as claims dependent on an allowable claim, the Examiner is respectfully requested to provide specific references supporting the rejection.

### **Conclusion**

Claims 1-13 are pending.

For at least the reasons presented above, the Applicant respectfully submits that the pending claims are allowable and looks forward to the early issuance of a Notice of Allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,  


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